Remarks

Claims 1, 23, and 42-45 are pending in the application. Claims 1, 23, and 45 stand rejected. Claims 42-44 are allowed. No claims were amended or canceled. Furthermore, the Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Claim Rejections Based on 35 USC § 103(a)

Claims 1, 23 and 45 stand rejected under 35 USC § 103(a), based on the Examiner's contention that they are upatentable over U.S. Patent 6,693,178 ("the '178 patent") in view of Sabesan (U.S. Patent 5,095,123). The Examiner contends that the '178 patent "constitutes prior art only under 35 USC § 102(e)." The Applicants respectfully disagree.

The Applicants respectfully assert that the '178 patent is not available as prior art under 35 USC § 103(a) because the '178 patent does not qualify as prior art under 35 USC § 102(e). The application that matured into U.S. Patent 6,693,178 was a divisional filed on May 15, 2002, claiming priority to U.S. Patent Application 09/717,197 (now U.S. Patent 6,426,421), filed on November 21, 2000; which in turn claimed priority to U.S. Provisional Application 60/167,302, filed on November 24, 1999. Hence, the earliest possible § 102(e) date for the '178 patent is November 24, 1999.

The instant application is a continuation of U.S. Patent Application 09/413,381 (now U.S. Patent 6,323,339) filed on October 6, 1999; which claims priority to U.S. Provisional Application 60/103,291, filed on October 6, 1998.

Accordingly, because the instant application is a continuation application and the filing dates of both the parent application (October 6, 1999) and the underlying provisional application (October 6, 1998) precede the earliest possible § 102(e) date (November 24, 1999) for the '178 patent, the Applicants respectfully assert that the '178 patent is not prior art under § 102(e) against the instant application.

Accordingly, the Applicants respectfully request the withdrawal of the rejection of claims 1, 23 and 45 under 35 USC § 103(a).

In addition, the Examiner comments that the compounds disclosed in reaction scheme 1 and examples 2, 3, and 5 of U.S. Patent 5,095,123 fall within the scope of instant claims 1 and 23. The Applicants respectfully remind the Examiner that the compounds described in reaction scheme 1 and examples 2, 3, and 5 of U.S. Patent 5,095,123 are diphenyl phosphates, which compounds do not fall within the scope of pending claims 1 and 23. Please see the previous Office Communication responses dated January 15, 2004 and June 6, 2003 for a discussion of the fact that the diphenyl phosphates disclosed in U.S. Patent 5,095,123 do not fall within the scope of the amended claims. Therefore, the Applicants contend that U.S. Patent 5,095,123 alone cannot establish a *prima facie* case of obviousness for the rejected claims. In this regard, the Applicants respectfully remind the Examiner that in order "to establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *MPEP* 2143.03. *See also In re Royka*, 490 F.2d 981.

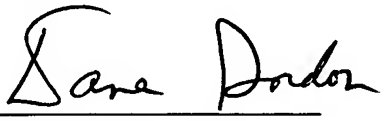
Fees

The Applicants believe they have provided for the required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account, **06-1448**.

Conclusion

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. The Applicants respectfully request reconsideration and withdrawal of the pending rejections. The Applicants thank the Examiner for careful consideration of the present case. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

Respectfully submitted,
FOLEY HOAG LLP



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